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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/510,437	10/07/2004	Daniel Patrick Morris	056258-5076	7503
9629 7590 07/25/2007 MORGAN LEWIS & BOCKIUS LLP 1111 PENNSYLVANIA AVENUE NW WASHINGTON, DC 20004			EXAMINER RODEE, CHRISTOPHER D	
			ART UNIT 1756	PAPER NUMBER
			MAIL DATE 07/25/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

10/510,437

Applicant(s)

MORRIS ET AL.

Examiner

Christopher RoDee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 17 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 56-88 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 66-68 and 73-88 is/are allowed.
- 6) ☒ Claim(s) 56-65 and 69-72 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 56-65 and 69-72 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ohno *et al.* in US Patent 6,096,468.

This rejection was presented in the last Office action. Applicants traverse the rejection because none of the exemplified toners have the combination of characteristics required by the instant claims, and particularly none of the claims have a both SF-1 and SF-1/SF-2 within the scope of the claims. Further, applicants take the position that the reference teaches away from the combination of these features and includes within its scope for SF-1 values outside the scope of the claims.

As discussed in the last Office action, the toner has shape factors SF-1 and SF-2 with a value of  $100 < \text{SF-1} \leq 160$  and a value of  $100 < \text{SF-2} \leq 140$  (col. 3, l. 66-67). The toner also has an average circularity of from 0.920 to 0.995 (col. 8, l. 34-55). The Examiner also referred specifically to Toners G, L, M, and N. As seen in Tables 3A and 8, Toners G, L, and M have SF-1 values (150, 142, 148) and circularities (0.945, 0.964, 0.952) within the scope of the instant claims, while Toner N has a SF-1/SF-2 ratio within the scope of the claims (i.e., 1.12).

The Examiner maintains the position that the artisan would reasonably be expected to combine toner shape characteristics within the scope of the reference's teachings and particularly at or near those exemplified to produce an effective toner according to Ohno. The reference teaches SF-1 of from above 100 to 160, inclusive. Clearly some of these values are

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outside the scope of the claims, but the reference exemplifies specific values within this range that are also within the scope of the instant claims. As noted above, Toners G, L, and M all have SF-1 values of 150, 142, and 148, respectively, that all fall within the scope of the pending claims. This is sufficient direction to motivate the artisan to prepare a toner having these SF-1 values because the reference specifically prepares toners with these values. The artisan would recognize that the values are effective for forming toners having good transfer characteristics. Additionally, the reference specifically recognizes that the ratio of SF-1 and SF-2 are result effecting (col. 8, l. 27-28). The artisan would have ample motivation to produce a toner having a ratio of SF-1 and SF-2 exemplified by the reference in order to obtain the reduced melt adhesion and reduced filming (col. 8, l. 13-19). Toner L has a SF-1/SF-2 ratio of 1.136 and an SF-1 value within the scope of the claims (i.e., 142). The ratio of SF-1/SF-2 ratio of 1.136 is just outside the scope of the claims as recognized in applicants' remarks. However, Toner N has a SF-1/SF-2 ratio is 1.12, which falls within the scope of the claims. Given not only the general teachings but the specific teachings, the artisan would have ample motivation to produce a toner having a SF-1 value as disclosed in Toners G, L, or M, with a SF-1/SF-2 ratio as taught for Toner N.

The Examiner notes applicants' arguments that the reference teaches away from the combination of characteristics presented in the instant claims noting that certain results are the "least best". In response the Examiner reminds applicants that a reference is valid for all it teaches, not just the most preferred embodiments. The fact that certain embodiments have better results than others does not mean that the reference is teaching away from the less preferred embodiments. All the inventive embodiments are within the scope of the claims and are valid teachings of the reference.

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Finally, with respect to the evidence in the specification, only Toners 3 and 6 may be within the scope of the claims. These toners have SF-1 values of 142 and 139, respectively. These toners also have a SF-1/SF-2 ratio of 1.11 and 1.09 and mean circularity of 0.95 and 0.94, respectively. These limited examples are not representative of the scope of the claims because the claims include any circularity greater than 0.90, any SF-1 value between 130 and 150 and any SF-1/SF-2 ratio of from 1.07 to 1.13. Applicants have not shown an unexpected result for the scope of the claims based on these limited examples. Further, none of the comparison examples appear to be with the applied art. Each of the Ohno examples requires SF-1/SF-2 ratio of greater than 1. Consequently, Toners 4 and 7 are not within the scope of the applied art. Further, the reference discloses toners with SF-1 values within the scope of the claims (e.g., Toners G, L, and M) and comparative examples outside the scope of the reference disclosure are not effective to show an unexpected result because they are not proper comparatives.

It is also unclear what the wax diameter is for these examples. This is a critical feature of the claims and it is not apparent that inventive examples 3 and 6 meet this requirement.

The proceedings in the European Patent Office referenced by applicants are not germane to proceedings in the USPTO.

The rejection is maintained because the art would reasonably suggest to the skilled artisan toners within the scope of the claims and there is insufficient evidence to show an unexpected result for the claimed toners as compared to those of Ohno.

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***Allowable Subject Matter***

Claims 66-68 and 73-88 are allowed.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher RoDee whose telephone number is 571-272-1388. The examiner can normally be reached on Monday to Thursday from 5:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Huff can be reached on 571-272-1385. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Christopher RoDee/  
Primary Examiner  
Art Unit 1756

cdr  
17 July 2007